

REMARKS

In the Office Action, claims 46-57 are withdrawn from consideration as being directed to a non-elected invention. Claims 28, 31, and 35 are objected to under 37 CFR 1.75(c) as being of improper dependent form. Claims 30, 32, 37 and 45 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claims 28, 38 and 45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 10 or 15 of U.S. Patent No. 6,706,245 to Neal, et al. in view of U.S. Patent No. 6,544,799 to Lewis et al. Also, claim 36 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 30-35 and 37 are also indicated as being allowable, provided that they are rewritten to overcome the rejections under 35 U.S.C. § 112, second paragraph and rewritten to include all of the limitations of the base claim and any intervening claims.

Applicants extend their gratitude for the courtesies extended by the Examiner during the telephone interview referred to in the Office Action, as well as the telephone interview of April 12, 2005. In response to the Examiner's characterization of the interview in the Office Action, Applicants note that they have only asserted that claim 46 and original claim 24 are not directed to inventions that are independent or distinct. Applicants have not asserted that claim 46 and original claim 24 are of the same breadth or scope.

Objections under 37 CFR 1.75(c):

Applicants have herein amended claim 28 to recite, “wherein the autosampler is adapted to perform sample extractions from the specimen, and wherein the specimen comprises at least one of a soil sample and a water sample.” Applicants have also herein amended claims 31 and 35 to recite, “the solvent reservoir comprises at least one of water and methanol,” and, “the second solvent reservoir comprises at least one of water and methanol,” respectively. Applicants submit that these amendments address the Examiner’s concerns.

Rejections Under 35 U.S.C. § 112, Second Paragraph:

Applicants have herein amended claim 30 to recite, “a closed position,” and “an open position.” Applicants have also herein amended claim 45 to recite, “a first flow path in line with the top stage of the needle,” and deleted prior references to the first flow path. Applicants submit that these amendments address the Examiner’s concerns.

Applicants have also amended claim 45 to recite, “a needle adapted to inject and extract gas and liquid from the vial.” Applicants have made this amendment to cause both gas and liquid to be of the same number.

Obviousness-Type Double Patenting Rejections:

Applicants acknowledge the rejection of claims 28, 38 and 45 under the judicially created doctrine of obviousness-type double patenting, and request that the rejection be held in abeyance until claims 28, 38 and 45 are otherwise allowable.

Withdrawal of claims 46-57:

Applicants traverse the withdrawal of claims 46-57 as being directed to a non-elected invention. Applicants submit that claims 46-57 are directed to inventions that are not independent or distinct from the invention originally elected in response to the Office Action mailed on August 25, 2003. In traversing the withdrawal, Applicants do not make any admission that the claimed inventions are obvious in view of one another.

In response to the restriction requirement set forth in the Office Action mailed on August 25, 2003, Applicants elected the group IV including, "Claims 24-27 drawn to a vial autosampler for performing both gas and liquid extractions, classified in class 422, subclass 101." See 8/25/03 Office Action at 2. Applicants note that claims 46-57 are also drawn to, "[a] vial autosampler for performing both liquid and gas sample extractions . . ." Applicants respectfully submit that the Examiner has failed to establish, or concisely state proper reasons that claims 46-57 are directed to inventions independent or distinct from this originally elected invention. *See, MPEP § 816* (stating that, "The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate.")

In the Office Action, the Examiner does state that Claims 46-57 are directed to independent or distinct inventions because claim 46, "does not require the particulars of claim 24." See 1/19/05 Office Action at 2. The Examiner cites no authority for the proposition that two claims are directed to independent or distinct

inventions if they do not require the same, "particulars," nor are Applicants able to find such authority.¹

In the telephonic interview of April 12, 2005, the Examiner indicated that the withdrawal of claims 46-57 was proper because examining claims 46-57 would require the Examiner to perform an additional search. Applicants do not understand how this meets the standard for a proper restriction. Restriction is proper only where, (1) the inventions are independent or distinct, **and** (2) there is a serious burden on the Examiner. See MPEP § 803. As both original claim 24 and claims 46-57 are drawn to, "[a] vial autosampler for performing both liquid and gas sample extractions from a specimen contained in a vial," Applicants do not understand why an additional search is required or how an additional search constitutes a serious burden on the Examiner. Also, Applicants submit that the Examiner has failed to demonstrate that the inventions of claims 46-57 are separate and distinct from the invention of original claim 24, and therefore the withdrawal of claims 46-57 is improper regardless of the burden on the Examiner. *See id.*

Additionally, Applicants submit that the withdrawal of claims 46-57 is improper because claims 46-57 and the elected invention define the same essential characteristics of a single disclosed embodiment. Applicants invite the Examiner's attention to MPEP § 806.03, which states that restriction should **never** be required where claims, "define the same essential characteristics of a single disclosed embodiment." *See id.* Applicants again note that both claim 46 and original claim 24 are directed to, "[a] vial autosampler for performing both liquid and gas sample extractions from a specimen contained in a vial."

¹ Applicants note that the Examiner appears to have compared the "particulars" of claim 46 to claim 45 or canceled claim 29, not to the originally elected claim 24. See Office Action at 2-3. For example, claim 24 has never recited, "a needle comprising a bottom, middle, and top stage, each with apertures," as suggested in the Office Action. *See id.*

Based on the above rationale, Applicants strongly believe that the withdrawal of claims 46-57 is improper. Should the withdrawal of claims 46-57 be maintained, Applicants' next step will be to file a petition to the Commissioner under 37 CFR 1.44.

CONCLUSION

Applicants believe that they have fully addressed each basis for rejection. Favorable reconsideration of the claims of the subject application and issuance of a Notice of Allowance is respectfully requested. Should the Examiner have any remaining concerns, he is requested to contact the undersigned at the telephone number below so that those concerns may be addressed without the necessity for issuing an additional Office Action.

Respectfully submitted,



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